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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM L. THOMAS

Appeal 2009-003302
Application 09/809,922
Technology Center 3700

Decided: October 2, 2009

Before TONI R. SCHEINER, MELANIE L. MCCOLLUM, and
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

FREDMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving a method of interactive wagering. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

Statement of the Case

The Claims

Claims 1-32 are on appeal. Claims 1, 6, 10, and 21 are representative and read as follows:

1. A method for using an interactive wagering application to allow a user in a particular location to participate in lottery wagering using user equipment, comprising:
 - determining the particular location of the user;
 - providing a listing of lotteries in which the user can participate on a visual display based on the particular location of the user;
 - giving the user the ability to participate in at least one of the lotteries using the user equipment; and
 - issuing an electronic lottery ticket for the at least one of the lotteries, wherein a lottery drawing for the at least one of the lotteries will take place at a later time.
6. The method of claim 1 further comprising recording, in a multimedia format, the lottery drawings associated with the lotteries in which the user participated.
10. The method of claim 1 further comprising: creating a wager based on user inputs;
 - giving the user the ability to finalize the wager at a later time; and
 - reminding the user to finalize the wager.
21. A method for using an interactive wagering application to allow a user to participate in a lottery automatically using electronic user equipment, comprising:
 - giving the user the ability to specify conditions via the user equipment on which the interactive wagering application is at least partially implemented;
 - automatically participating in the lottery on behalf of the user when the conditions have been met; and

notifying the user of the automatic participation in the lottery.

The prior art

The Examiner relies on the following prior art references to show unpatentability:

Small US 4,815,741 Mar. 28, 1989

Luciano US 6,168,521 B1 Jan. 2, 2001

Archer US 6,277,026 B1 Aug. 21, 2001

Walker US 6,325,716 B1 Dec. 4, 2001

Schneier US 6,402,614 B1 Jun. 11, 2002

Rittmaster US 2002/0023010 A1 Feb. 21, 2002

McCollom US 2002/0010623 A1 Jan. 24, 2002

Dickerson GB 2,147,773 A May 15, 1985

Lottobot,
<http://web.archive.org/web/19991128172018/http://lottobot.net/> (Feb. 1999),
pp. 1-22.

SGI insights, 1(5) SCIENTIFIC GAMING INTERNATIONAL 1-4 (Jan. 1999).

The issues

- A. The Examiner rejected claims 1-6 and 11-16 under 35 U.S.C. § 103(a) as being obvious over Schneier and Archer (Ans. 3-5).
- B. The Examiner rejected claims 1 and 11 under 35 U.S.C. § 103(a) as being obvious over Dickinson, Rittmaster, and Archer (Ans. 5-7).
- C. The Examiner rejected claims 2-5, 7, 9, 12-15, 17, and 19 under 35 U.S.C. § 103(a) as being obvious over Dickinson, Rittmaster, Archer and Lottobot (Ans. 7-8).
- D. The Examiner rejected claims 6 and 16 under 35 U.S.C. § 103(a) as being obvious over Dickinson, Rittmaster, Archer and Luciano (Ans. 9).
- E. The Examiner rejected claims 8 and 18 under 35 U.S.C. § 103(a) as being obvious over Dickinson, Rittmaster, Archer and SGI (Ans. 10).
- F. The Examiner rejected claims 10 and 20 under 35 U.S.C. § 103(a) as being obvious over Dickinson, Rittmaster, Archer and McCollom (Ans. 10-11).
- G. The Examiner rejected claims 21-32 under 35 U.S.C. § 103(a) as being obvious over Walker, Archer and Small (Ans. 11-13).

A. 35 U.S.C. § 103(a) over Schneier and Archer

The Examiner rejected claims 1-6 and 11-16 under 35 U.S.C. § 103(a) as being obvious over Schneier and Archer (Ans. 3-5).

The Examiner finds that “Schneier et al disclose determining the particular location of the user . . . providing a listing of lotteries in which the user can participate on a visual display based on the particular location of the user . . . giving the user the ability to participate in at least one of the lotteries using the user equipment” (Ans. 3). The Examiner finds that

“Schneier et al does not expressly disclose . . . issuing an electronic lottery ticket . . . wherein a lottery drawing for the at least one of the lotteries will take place at a later time” (Ans. 5). The Examiner finds that “Archer teaches . . . issuing an electronic lottery ticket for the at least one of the lotteries, wherein a lottery drawing for the at least one of the lotteries will take place at a later time” (*Id.*). The Examiner finds it obvious to combine Schneier and Archer to “allow[] a user to retrieve the[] results of a lottery ticket either online or [at] an authorized payment center” (*Id.*).

Appellant argues that “[f]irst, the Examiner has failed to point out any suitable suggestion or motivation to combine Schneier and Archer. Second, there cannot exist a suggestion or motivation to combine Schneier with Archer in the manner suggested by the Examiner at least because Schneier teaches away from such a combination” (App. Br. 12-13). Appellant also argues that

the Examiner fails to indicate why one skilled in the art would modify Schneier from providing instant lotteries to providing lotteries whose associated drawings take place at a later time. The only lotteries that Schneier mentions are instant-type lotteries having predetermined results and Schneier’s entire disclosed system is contingent on the fact that the lotteries are instant with predetermined results.

(Reply Br. 3.)

In view of these conflicting positions, we frame the obviousness issue before us as follows:

Has Appellant demonstrated that the Examiner erred in concluding that it would have been obvious to modify Schneier to issue an electronic lottery ticket for a later lottery drawing as taught by Archer?

Findings of Fact (FF)

1. The Examiner finds, and Appellant does not dispute, that Schneier teaches the determining the particular location of a user, providing a listing of lotteries in which the user can participate and giving the user the ability to participate in the steps required by claim 1 (*see Ans. 3-4*). We therefore adopt the Examiner's fact finding regarding Schneier.

2. The Examiner finds, and Appellant does not dispute, that Archer teaches issuing electronic lottery tickets for lotteries, where a lottery drawing will take place at a later time (*see Ans. 5*). We therefore adopt the Examiner's fact finding regarding Archer.

3. The Examiner finds that

it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Schneier et al to include issuing an electronic lottery ticket for the at least one of the lotteries, wherein a lottery drawing for the at least one of the lotteries will take place at a later time as taught by Archer to provide known methods to yield to predictable results that allows a user to retrieve the[] results of a lottery ticket either online or [at] an authorized payment center.

(Ans. 5.)

Principles of Law

The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) secondary considerations of

nonobviousness, if any. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). The Supreme Court has emphasized that “the [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int'l v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416. “If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 417. Moreover, an “[e]xpress suggestion to substitute one equivalent for another need not be present to render such substitution obvious.” *In re Fout*, 675 F.2d 297, 301 (CCPA 1982). As noted by the Court in *KSR*, “[a] person of ordinary skill is also a person of ordinary creativity, not an automaton.” 550 U.S. at 421.

Analysis

Applying the *KSR* standard of obviousness to the Examiner’s findings of fact, we agree with the reasoning of the Examiner. It is undisputed that Schneier teaches determining the particular location of a user, providing a listing of lotteries in which the user can participate, and giving the user the ability to participate in the steps required by claim 1 (*see* Ans. 3-4; FF 1). It is also undisputed that Archer teaches issuing electronic lottery tickets for lotteries, where a lottery drawing will take place at a later time (*see* Ans. 5; FF 2).

The Examiner provides several specific reasons to use the Archer method, including that “[b]y issuing lottery tickets for lottery drawings for a

later time, one of ordinary skill in the art provide a system that facilitates the sale of lottery tickets without disturbing bearer-type tickets and the like” (Ans. 14). The Examiner also reasons that modifying Schneier “to include the purchasing of an electronic ticket for at least one lotteries, wherein the drawing for the at least one lotteries will take place at a later time as taught by Archer” yields “predictable results that allows a user to retrieve there [sic, their] results of a lottery ticket either online or an authorized payment center” (Ans. 14-15).

We agree with the Examiner that the combination of Schneier and Archer is a “predictable use of prior art elements according to their established functions.” *KSR*, 550 U.S. at 417.

We are not persuaded by Appellant’s argument that the “motivation that the Examiner has pointed to in Archer (i.e., the elimination of bearer-type tickets) is insufficient because it is merely conclusory. Appellant submits, therefore, that the Examiner’s purported motivation is a broad, conclusory statement without factual support” (App. Br. 14). In *KSR*, the Supreme Court rejected the rigid application of the teaching, suggestion, and motivation test by the Federal Circuit, stating that

The principles underlying [earlier] cases are instructive when the question is whether a patent claiming the combination of elements of prior art is obvious. When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.

KSR, 550 U.S. at 417. Instead, the Supreme Court found that “a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* The substitution of a delayed lottery type ticket of Archer for the lottery tickets of Schneier is reasonably understood as a predictable variation which would have been obvious to the creative artisan of ordinary skill.

We also do not find persuasive Appellant’s argument that the Examiner’s reasons for combination are “wholly insufficient” (Reply Br. 3). The Examiner has provided a specific reason to combine the references, which is sufficient to provide a case of obviousness. Appellant has provided no rebuttal evidence.

We are not persuaded by Appellant’s argument that “the Examiner has employed hindsight reconstruction in combining the references” (App. Br. 15). Modification of Schneier’s lottery method to issue delayed game lottery tickets as taught by Archer is the product of ordinary skill, ordinary creativity and common sense, not of innovation. *See KSR*, 550 U.S. at 421. Thus, no impermissible hindsight was employed by the Examiner.

We are not persuaded by Appellant’s argument that Schneier teaches away from the invention because “the system of Schneier is not capable of supporting a lottery for which drawing takes place at a later time” (App. Br. 17). This argument requires Schneier to anticipate the claim in order to render it obvious. Further, there is no specific teaching in Schneier which teaches away from the use of a lottery in which the drawing takes place later. Like our appellate reviewing court, “[w]e will not read into a reference a teaching away from a process where no such language exists.” *DyStar*

Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co., 464 F.3d 1356, 1364 (Fed. Cir. 2006).

Conclusion of Law

Appellant has not demonstrated that the Examiner erred in concluding that it would have been obvious to modify Schneier to issue an electronic lottery ticket for a later lottery drawing as taught by Archer.

B. - 35 U.S.C. § 103(a) over Dickinson, Rittmaster, and Archer

The Examiner rejected claims 1 and 11 under 35 U.S.C. § 103(a) as being obvious over Dickinson, Rittmaster, and Archer (Ans. 5-7).

The Examiner finds that Dickinson teaches “providing a listing of lotteries in which the user can participate on a visual display . . . and giving the user the ability to participate in at least one of the lotteries using the user equipment” (Ans. 6). The Examiner finds that Rittmaster teaches determining the location of users and that “limiting lottery availability based on geographic information determined from players helps to ensure lottery legality in certain jurisdictions” (Ans. 6). The Examiner finds that Archer teaches “issuing an electronic lottery ticket for the at least one of the lotteries, wherein a lottery drawing for the at least one of the lotteries will take place at a later time” (Ans. 6).

The Examiner finds it would have been obvious to modify Dickinson et al to include limit[ed] lottery availability based on geographic information determined from players and issuing electronic tickets for lotteries taking place at a later time as taught by Rittmaster et al and Archer to ensure lottery legality in certain jurisdictions . . . and provide known methods to yield to predictable results that allow[] a user to retrieve . . . results of a lottery ticket either online or [at] an authorized payment center.

(Ans. 7.)

Appellant argues that “[f]irst, the Examiner has failed to point out any suitable suggestion or motivation to combine Dickinson, Rittmaster and Archer” (App. Br. 21). Appellant also argues that “[s]econd, there cannot exist a suggestion or motivation to combine Dickinson with Rittmaster and Archer in the manner suggested by the Examiner at least because Dickinson teaches away from such a combination” (App. Br. 21).

In view of these conflicting positions, we frame the obviousness issue before us as follows:

Has Appellant demonstrated that the Examiner erred in concluding that it would have been obvious to modify Dickinson to limit player access to legal lotteries as taught by Rittmaster and to issue an electronic lottery ticket for a later lottery drawing as taught by Archer?

Findings of Fact (FF)

4. The Examiner finds, and Appellant does not dispute, that Dickinson teaches “providing a listing of lotteries in which the user can participate on a visual display . . . and giving the user the ability to participate in at least one of the lotteries using the user equipment” (Ans. 6). We therefore adopt the Examiner’s fact finding regarding Dickinson.

5. The Examiner finds, and Appellant does not dispute, that Rittmaster teaches “limiting lottery availability based on geographic information determined from players helps to ensure lottery legality in certain jurisdictions” (Ans. 6). We therefore adopt the Examiner’s fact finding regarding Rittmaster.

6. The Examiner finds, and Appellant does not dispute, that Archer teaches issuing electronic lottery tickets for lotteries, where a lottery drawing will take place at a later time (*see Ans. 5*). We therefore adopt the Examiner's fact finding regarding Archer.

7. The Examiner finds that

it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Dickinson et al to include limit[ed] lottery availability based on geographic information determined from players and issuing electronic tickets for lotteries taking place at a later time as taught by Rittmaster et al and Archer to ensure lottery legality in certain jurisdictions as desirabl[e] and provide known methods to yield to predictable results that allow[] a user to retrieve . . . results of a lottery ticket either online or [at] an authorized payment center.

(Ans. 7.)

Analysis

Applying the *KSR* standard of obviousness to the Examiner's findings of fact, we agree with the reasoning of the Examiner. It is undisputed that Dickinson teaches electronically providing lottery listings and permitting player participation (FF 4). Rittmaster teaches determining the particular location of a user, providing a listing of lotteries in which the user can participate and giving the user the ability to participate in steps required by claim 1 (FF 5). It is also undisputed that Archer teaches issuing electronic lottery tickets for lotteries, where a lottery drawing will take place at a later time (FF 6).

We are not persuaded by Appellant's argument that "without a proper showing of a suggestion or motivation to combine the references, a finding

of obviousness is improper" (App. Br. 23). We have already pointed out that in *KSR*, the Supreme Court rejected the rigid application of the teaching, suggestion, and motivation test upon which Appellant's arguments regarding reason to combine rely (see App. Br. 21-23; *KSR*, 550 U.S. at 417). "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR*, 550 U.S. at 416.

We are not persuaded by Appellant's argument that "the Examiner fails to indicate why one skilled in the art would modify Dickinson from providing a stationary, stand-alone lottery machine that is preprogrammed to provide certain games to a machine that determines the user's location" (Reply Br. 5).

The Examiner provides at least one clear reason to use Rittmaster with Dickinson, which is to ensure that users of the Dickinson device will stay within the law and only participate in lotteries which are legal for their geographic location (FF 7). Simply because the lottery machine is a stand-alone, stationary device does not suggest that when the device is installed, there is no interest in ensuring that the location is legal. Further, there is no reason to suppose that even stand alone devices may not, occasionally, be subject to a transfer of location.

The Examiner also provides a specific reason to use the Archer method with those of Dickinson and Rittmaster, that "[b]y issuing lottery tickets for lottery drawings for a later time, one of ordinary skill in the art provide[s] known methods to yield [the] predictable result[] that a user" can

retrieve their lottery results “either online or at an authorized payment center” (Ans. 16).

We agree with the Examiner that the combination of Dickinson, Rittmaster and Archer is a “predictable use of prior art elements according to their established functions.” *KSR*, 550 U.S. at 417.

We are not persuaded by Appellant’s argument that “the Examiner has employed hindsight reconstruction in combining the references” (App. Br. 23). Modification of Dickinson’s lottery method to limit use to legal jurisdictions as taught by Rittmaster and to issue delayed game lottery tickets as taught by Archer is the product of ordinary skill, ordinary creativity and common sense, not of innovation. *See KSR*, 550 U.S. at 421. Thus, no impermissible hindsight was employed by the Examiner.

We are not persuaded by Appellant’s argument that “Dickinson actually teaches away from being modified to include the features of [A]ppellant’s claimed invention” (App. Br. 24). Appellant identifies no specific teaching in Dickinson which teaches away from ensuring that the stand-alone lottery machine is sited in a legal location, as taught by Rittmaster (*see* App. Br. 25-26). Like our appellate reviewing court, “[w]e will not read into a reference a teaching away from a process where no such language exists.” *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1364 (Fed. Cir. 2006).

Conclusion of Law

Appellant has not demonstrated that the Examiner erred in concluding that it would have been obvious to modify Dickinson to limit player access

to legal lotteries as taught by Rittmaster and to issue an electronic lottery ticket for a later lottery drawing as taught by Archer.

C. - 35 U.S.C. § 103(a) over Dickinson, Rittmaster, Archer and Lottobot

The Examiner rejected claims 2-5, 7, 9, 12-15, 17, and 19 under 35 U.S.C. § 103(a) as being obvious over Dickinson, Rittmaster, Archer and Lottobot (Ans. 7-8).

The Examiner finds that the “combination of Dickinson et al. and Rittmaster et al. and Archer teaches a method and system as described above with respect to claims 1 and 11” (Ans. 7). The Examiner finds that “the combination of Dickinson et al. and Rittmaster et al. and Archer does not explicitly teach various lottery functions recited in dependent claims 2-5, 7, 9, 12-15, 17 and 19” (Ans. 7-8). The Examiner finds it obvious to “to incorporate the notification of lottery results and winning numbers of LottoBot into the combination of Dickinson et al. and Rittmaster et al. and Archer in order to increase player convenience” (Ans. 8).

The Examiner provides sound fact-based reasoning for combining Lottobot with Dickinson, Rittmaster and Archer. As Appellant does not identify any material defect in the Examiner's reasoning, we affirm the rejection of claims 2-5, 7, 9, 12-15, 17, and 19 for the reasons stated by the Examiner.

D. - 35 U.S.C. § 103(a) over Dickinson, Rittmaster, Archer and Luciano

The Examiner rejected claims 6 and 16 under 35 U.S.C. § 103(a) as being obvious over Dickinson, Rittmaster, Archer and Luciano (Ans. 9).

The Examiner finds that the “combination of Dickinson et al. and Rittmaster et al. and Archer teaches a method and system as described above

with respect to claims 1 and 11” (Ans. 7). The Examiner finds that Dickinson and Rittmaster do not “explicitly teach recording, in a multimedia format, the lottery drawings associated with the lotteries in which the user participated” (Ans. 9). The Examiner finds that Luciano teaches “that the player can activate a stored replay of the draw” (Ans. 9). The Examiner finds that it obvious to “incorporate the recordation of lottery results in a multimedia format presented to players of the lottery as taught by Luciano et al. into the lottery method and system as taught by the combination of Dickinson et al., Rittmaster and Archer in order to increase player excitement and entertainment” (Ans. 9).

Appellant argues that “[w]hether taken alone or in combination, neither Dickinson nor Rittmaster nor Archer nor Luciano shows or suggests recording, in a multimedia format, the lottery drawings associated with the lotteries in which a user participated” (App. Br. 28-29). Appellant argues that “Luciano stores the results (i.e., winning numbers) of lottery drawings in a numerical format, but does not record lottery drawings in a multimedia format as required by [A]ppellant's claims” (App. Br. 29).

In view of these conflicting positions, we frame the obviousness issue before us as follows:

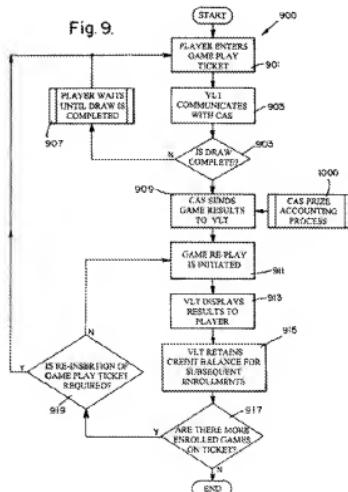
Has Appellant demonstrated that the Examiner erred in concluding that it would have been obvious over the cited art to record “in a multimedia format, the lottery drawings associated with the lotteries in which the user participated” as required by claims 6 and 16?

Findings of Fact

8. The Specification teaches that “the interactive wagering application may provide the user with the ability to schedule a recording of the lottery drawing” (Spec. 41, ll. 11-13).

9. The Specification teaches that “the lottery drawing, assuming it is broadcasted, may be recorded using any suitable recording technique” (Spec. 41, ll. 15-17).

10. Figure 9 of Luciano is reproduced below:



“Figure 9 is a flow diagram illustrating the game result process” (Luciano, col. 2, ll. 20-21).

11. Luciano teaches that “[t]he game replay feature is one advantageous aspect of the invention. The central accounting system 110 has

stored in a memory a plurality of groups of video game plays. Each group of game plays corresponds to a winning or losing draw grouping" (Luciano, col. 8, ll. 40-44).

12. Luciano teaches that "[w]ithin each group of video game plays, several different video game plays are stored. When a player replays the outcome of his lottery draw for a game, the central accounting server 110 identifies the specific group of video game plays to be chosen according to the player's draw outcome for a game" (Luciano, col. 8, ll. 49-54).

13. Dickinson teaches a lottery game terminal with where "[v]ideo processor 37 provides signals to select and display images on color monitor 20" (Dickinson 3, l. 35).

14. Dickinson teaches that "[f]lexible programming capability allows a wide variety of sound effects and music to be produced with a single system" (Dickinson 4, ll. 6-7).

Analysis

The Specification does not provide any specific limitations on what constitutes a "multimedia format" and the originally filed Specification does not actually include that phrase, teaching that any recording technique may be used (FF 8-9). Luciano teaches that video lottery games may be replayed (FF 10-12). Dickinson teaches that video lottery games may include color monitor images and sound effects including music (FF 13-14).

We are not persuaded by Appellant's argument that "[w]hether taken alone or in combination, neither Dickinson nor Rittmaster nor Archer nor Luciano shows or suggests recording, in a multimedia format, the lottery drawings associated with the lotteries in which a user participated" (App. Br.

28-29). In fact, Luciano specifically teaches that “[t]he game replay feature is one advantageous aspect of the invention” (Luciano, col. 8, ll. 40-41; FF 10). In replaying the video lottery games, particularly the games disclosed by Dickinson, Dickinson teaches the use of color images, sound and music, which are reasonably construed as “multimedia” (FF 13-14).

We therefore agree with the conclusion of the Examiner that it would have been obvious to record lottery drawings in a multimedia format since Dickinson teaches presenting the lottery drawings in a multimedia format (FF 13-14) and Luciano teaches that for lottery drawings “[t]he game replay feature is one advantageous aspect of the invention” (Luciano, col. 8, ll. 40-41; FF 10).

Conclusion of Law

Appellant has not demonstrated that the Examiner erred in concluding that it would have been obvious over the cited art to record “in a multimedia format, the lottery drawings associated with the lotteries in which the user participated” as required by claims 6 and 16.

E. - 35 U.S.C. § 103(a) over Dickinson, Rittmaster, Archer and SGI

The Examiner rejected claims 8 and 18 under 35 U.S.C. § 103(a) as being obvious over Dickinson, Rittmaster, Archer and SGI (Ans. 10).

The Examiner finds that the “combination of Dickinson et al. and Rittmaster et al. and Archer teaches a method and system as described above with respect to claims 1 and 11” (Ans. 9). The Examiner finds that “the combination of Dickinson et al. and Rittmaster et al. and Archer does not explicitly teach generating lottery gift certificates” (Ans. 10). The Examiner finds it obvious “to incorporate the generation of lottery gift certificates as

taught by SGI Insights into the lottery method and system as taught by the combination of Dickinson et al., Rittmaster et al. and Archer in order to increase player appeal to the lottery games" (Ans. 10).

The Examiner provides sound fact-based reasoning for combining SGI with Dickinson, Rittmaster and Archer. As Appellant does not identify any material defect in the Examiner's reasoning, we affirm the rejection of claims 8 and 18 for the reasons stated by the Examiner.

F. - 35 U.S.C. § 103(a) over Dickinson, Rittmaster, Archer and McCollum

The Examiner rejected claims 10 and 20 under 35 U.S.C. § 103(a) as being obvious over Dickinson, Rittmaster, Archer and McCollom (Ans. 10-11).

The Examiner finds that the "combination of Dickinson et al. and Rittmaster et al. and Archer teaches a method and system as described above with respect to claims 1 and 11" (Ans. 10). The Examiner finds that the combination "does not explicitly teach giving the user the ability to finalize the wager at a later time and reminding the user to finalize the wager" (Ans. 11). The Examiner finds that McCollom teaches a "system in which users are able to purchase items and coupons over a network, wherein the users are able to finalize their purchase at a later time and be reminded to finalize their purchase" (Ans. 11). The Examiner finds it obvious to "incorporate the ability for users or purchases to finalize a purchase and be reminded of the same as taught by McCollom et al. into the lottery method and system as taught by the combination of Dickinson et al., Rittmaster and Archer" (Ans. 11).

Appellant argues that “McCollom merely refers to a wish list that is part of an online shopping application. The wish list of McCollom does not remind the user to complete a purchase stored in the wish list” (App. Br. 31). Appellant argues that “claims 10 and 20 are directed toward an interactive wagering application, which is not an analogous system to McCollom’s system for publishing, distributing and redeeming coupons” (*Id.*). Appellant argues that “the Examiner has failed to provide an objective motivation to combine these references” (*Id.*).

In view of these conflicting positions, we frame the obviousness issue before us as follows:

Has Appellant demonstrated that the Examiner erred in concluding that it would have been obvious over the cited art to give “the user the ability to finalize the wager at a later time” and remind “the user to finalize the wager” as required by claims 10 and 20?

Findings of Fact

15. The Specification teaches that “the interactive wagering application may remind the user of the unfinalized bet at any suitable time before the time of the lottery” (Spec. 39, ll. 23-26).

16. The Specification teaches that “[t]he reminder may take any suitable form” (Spec. 39, ll. 26-27).

17. McCollom teaches that the “list of ideas is an easy, flexible way for the consumer to maintain shopping lists, wish lists, etc. . . . The list of ideas helps the consumer to become comfortable with the idea of retaining items in preparation for future action” (McCollum 7 ¶ 0100).

18. McCollom teaches that “[o]n subsequent visits to this list of ideas, the last used list will be displayed and active” (McCollum 8 ¶ 0107).

19. McCollom teaches that “[i]f the shopper was here previously in this session, it remembers where he/she left off. For example, if the shopper left “Nugget” and went to the “Barnes & Noble” site . . . clicking on the “Advertisements” icon would bring him/her back to the same advertisement” (McCollum 11 ¶ 0146).

Analysis

As noted by the Court in *KSR*, “[a] person of ordinary skill is also a person of ordinary creativity, not an automaton.” 550 U.S. at 421. The person of ordinary creativity is taught by McCollom that shoppers may finalize purchases from their shopping lists at later date and shoppers may be reminded of the items in which they were interested by a website which returns the shopper to the shopping list (FF 18-19).

In our opinion, applying this shopping process to the purchase of lottery tickets is a “predictable use of prior art elements according to their established functions.” *KSR*, 550 U.S. at 417. We agree with the Examiner that the skilled artisan would have had reason to apply the McCollom shopping process to lotteries in order to permit shoppers to “browse, assemble and store lottery selections until electing to make a purchase” (Ans. 11).

We are not persuaded by Appellant’s argument that “claims 10 and 20 are directed toward an interactive wagering application, which is not an analogous system to McCollom’s system for publishing, distributing and

redeeming coupons" (App. Br. 31). In *Icon*, the Federal Circuit explained that

A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." *In re Clay*, 966 F.2d 656, 659 (Fed.Cir.1992). In other words, "familiar items may have obvious uses beyond their primary purposes." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007). We therefore have concluded, for example, that an inventor considering a hinge and latch mechanism for portable computers would naturally look to references employing other "housings, hinges, latches, springs, etc.," which in that case came from areas such as "a desktop telephone directory, a piano lid, a kitchen cabinet, a washing machine cabinet, a wooden furniture cabinet, or a two-part housing for storing audio cassettes." *Paulsen*, 30 F.3d at 1481-82.

In re ICON Health and Fitness, Inc., 496 F.3d 1374, 1379-1380 (Fed. Cir. 2007). In methods and systems for selling lottery tickets online, we find that an inventor would reasonably have considered references which are involved in selling other types of products online such as McCollom.

Conclusion of Law

Appellant has not demonstrated that the Examiner erred in concluding that it would have been obvious over the cited art to give "the user the ability to finalize the wager at a later time" and remind "the user to finalize the wager" as required by claims 10 and 20.

G. - 35 U.S.C. § 103(a) over Walker, Archer and Small

The Examiner rejected claims 21-32 under 35 U.S.C. § 103(a) as being obvious over Walker, Archer and Small (Ans. 11-13).

The Examiner finds that Walker teaches “giving the user the ability to set conditions via user equipment on which an interactive wagering application is partially implemented and automatically participating in the lottery on the behalf of the user when the conditions have been met” (Ans. 12). The Examiner finds that “Walker employs paper tickets and does not explicitly teach electronic user equipment, Archer teaches an analogous system for selling lottery tickets online via electronic user equipment” (*Id.*). The Examiner finds that “Small teaches an analogous system for notifying the user of the automatic participation in the lottery” (*Id.*). The Examiner finds it obvious “to incorporate the electronic user equipment and notify[] the user of the automatic participation in the lottery as taught by Archer and Small into the interactive wagering application of Walker et al. in order to facilitate the sale and distribution of lottery tickets” (*Id.*).

Appellant argues that “[f]irst, the Examiner has failed to point out any suitable suggestion or motivation to combine Walker with Archer and Small. Second, whether taken alone or in combination Walker, Small, and Archer do not show or suggest all of the elements of [A]ppellant's claims” (App. Br. 34-35). Appellant argues that “[w]hile Small refers to notifying a user that he has been automatically entered into a sweepstakes drawing, Small still does not show or suggest [A]ppellant's claimed feature of ‘notifying the user of the automatic participation in the lottery [when user specified conditions have been met]’” (App. Br. 39).

In view of these conflicting positions, we frame the obviousness issue before us as follows:

Has Appellant demonstrated that the Examiner erred in concluding that “automatically participating in the lottery on behalf of the user when the conditions have been met and notifying the user of the automatic participation in the lottery” would have been obvious?

Findings of Fact

20. Walker teaches a conditional lottery ticket system which “permits a player to purchase conditional lottery tickets (i) individually, whereby the player’s lottery ticket is activated the next time the player-specified activation conditions are satisfied” (Walker, col. 2, ll. 54-57).

21. Archer teaches “a method for facilitating the purchase and sale of a lottery ticket online . . . [which] includes a step of receiving an online request from a purchaser to purchase a lottery ticket in the context of a lottery operated by a lottery authority” (Archer, col. 2, ll. 31-36).

22. Small teaches a lottery in which “the sweepstakes processor 105 plays the automated sweepstakes-type game using indicia specific to the user” (Small, col. 10, ll. 60-62).

23. Small teaches that “[i]f desired, the user can be notified of the results of the sweepstakes at the end of his or her financial transaction” (Small, col. 10, ll. 63-65).

Analysis

Applying the *KSR* standard of obviousness to the findings of fact, we agree with the reasoning of the Examiner. Walker teaches a method where a user may purchase conditional lottery tickets which result in automatic

participation in the lottery when the conditions are met (FF 21). Archer teaches purchasing lottery tickets with electronic user equipment (FF 21). Small teaches the concept of automatically notifying the user of participation in the lottery and of the results of the lottery (FF 22-23).

The Examiner provides a specific reason to modify Walker using Archer and Small, specifically “to facilitate the sale and distribution of lottery tickets which enhances revenues and an inform that a user has been successfully entered in the lottery as desirably taught by Archer in col. 1:36-67 and Small” (Ans. 12). We agree with the Examiner that the combination of Walker, Archer, and Small is a “predictable use of prior art elements according to their established functions.” *KSR*, 550 U.S. at 417.

We are not persuaded by Appellant’s argument that “the Examiner has failed to point out any suitable suggestion or motivation to combine Walker with Archer and Small” (App. Br. 34-35). We have already pointed out that in *KSR*, the Supreme Court rejected the rigid application of the teaching, suggestion, and motivation test upon which Appellant’s arguments regarding reason to combine rely (*see* App. Br. 35-37; *KSR*, 550 U.S. at 417). “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 550 U.S. at 416.

We are not persuaded by Appellant’s argument that “the Examiner has employed hindsight reconstruction in combining the references” (App. Br. 37). Modification of Walker’s conditional lottery method to use electronically issued lottery tickets as taught by Archer with notification of the lottery results as taught by Small is the product of ordinary skill,

ordinary creativity and common sense, not of innovation. *See KSR*, 550 U.S. at 421. Thus, no impermissible hindsight was employed by the Examiner.

We are not persuaded by Appellant's argument that “[w]hile Small refers to notifying a user that he has been automatically entered into a sweepstakes drawing, Small still does not show or suggest [A]ppellant's claimed feature of ‘notifying the user of the automatic participation in the lottery [when user specified conditions have been met]’” (App. Br. 39). It is the combination of references which renders this notification obvious. That is, when the ordinary artisan implements the conditional lottery tickets of Walker on the electronic system of Small, the ordinary artisan would have reasonably followed Small's teaching to notify the participant of their participation in the lottery (FF 22-23).

Conclusion of Law

Appellant has not demonstrated that the Examiner erred in concluding that “automatically participating in the lottery on behalf of the user when the conditions have been met and notifying the user of the automatic participation in the lottery” would have been obvious.

SUMMARY

In summary, we affirm the rejection of claim 1 under 35 U.S.C. § 103(a) as being obvious over Schneier and Archer (Ans. 3-5). Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejection of claims 2-6 and 11-16, as these claims were not argued separately.

We affirm the rejection of claims 1 and 11 under 35 U.S.C. § 103(a) as being obvious over Dickinson, Rittmaster, and Archer.

We affirm the rejection of claims 2-5, 7, 9, 12-15, 17, and 19 under 35 U.S.C. § 103(a) as being obvious over Dickinson, Rittmaster, Archer and Lottobot (Ans. 7-8).

We affirm the rejection of claims 6 and 16 under 35 U.S.C. § 103(a) as being obvious over Dickinson, Rittmaster, Archer and Luciano (Ans. 9).

We affirm the rejection of claims 8 and 18 under 35 U.S.C. § 103(a) as being obvious over Dickinson, Rittmaster, Archer and SGI (Ans. 10).

We affirm the rejection of claims 10 and 20 under 35 U.S.C. § 103(a) as being obvious over Dickinson, Rittmaster, Archer and McCollom (Ans. 10-11).

We affirm the rejection of claim 21 under 35 U.S.C. § 103(a) as being obvious over Walker, Archer and Small (Ans. 11-13). Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejection of claims 22-32, as these claims were not argued separately.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED

Ssc:

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